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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/723,228	11/27/2000	Tadashi Goino	2842.01US01	6204

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EXAMINER

BORISSOV, IGOR N

ART UNIT	PAPER NUMBER
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3629

DATE MAILED: 10/12/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/723,228

Applicant(s)

GOINO, TADASHI

SA

Examiner

Igor Borissov

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 03 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 July 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-3,6-8,10-13,16-18,21-27,29,30,32 and 33 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3,6-8,10-13,16-18,21-27,29,30,32 and 33 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☒ Interview Summary (PTO-413)
Paper No(s)/Mail Date. 9/01/2004.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

EXAMINER'S AMENDMENT

An examiner's amendment to the record appears below. Should the changes and/or additions be unacceptable to applicant, an amendment may be filed as provided by 37 CFR 1.312. To ensure consideration of such an amendment, it **MUST** be submitted no later than the payment of the issue fee.

Authorization for this examiner's amendment was given in a telephone interview with Wm. Larry Alexander, (Reg. No. 37,269) on Wednesday, September 1, 2004.

The application has been amended as follows:

Claim 11, line 1, change "game" to "contest"; line 3, change "game" to "contest".

Claim 12, line 2, change "match" to "contest".

Claim 18, add a period "." at the end of the claim.

Claim 23, line 2, change "parameter" to "characteristic".

Claim 24, line 2, before "kenjutsu" add --a contest--; before "igo" add --a contest--; before "chess" add --a contest--; after "chess" add --a contest--; line 3, before "culture" add --a contest--; before "intellect" add --a contest--.

Claim 26, line 2, after "a zoom ratio of" add -- the image of--; line 3, after "the advertisement" add --displayed on the terminal computer--.

Response to Amendment

Claims 4-5, 9, 14-15, 19-20, 28 and 31 have been cancelled without prejudice by the applicant. Therefore, **claims 1-3, 6-8, 10-13, 16-18, 21-27, 29-30 and 32-33** are currently pending in the application.

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The objection of **claims 32 and 33** are withdrawn due to applicant's amendment.

The rejection of **claims 1, 6, 10-12, 16-18, 21-27, 29-30 and 32-33** under 35 U.S.C 112 are withdrawn due to applicant's amendment.

EXAMINER'S NOTICE

Upon reconsideration, **claims 1-3, 6-8, 10-13, 16-18, 21-27, 29-30 and 32-33**, previously indicated by the examiner as allowable, now stand rejected due newly obtained prior art.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-2, 6, 8, 10-12, 16-17, 24-25 and 29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gupta et al. (US 6,487,538 B1) (hereinafter Gupta) in view of Benson (US 6,470,079 B1) and further in view of Namanny et al. (US 6,254,478 B1) (hereinafter Namanny).

Claims 1 and 29. Gupta teaches a method and system for conducting a local advertising, said system including a server and a plurality of clients computers interconnected with the server via a network, wherein advertisement is presented to audiences during television or on-line program (C. 4, L. 5-18), and wherein the clients/advertisers can buy an advertisement slot, the price of

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which depends on advertisement size and slot location on a web page (site) (C. 12, L. 42-47). Furthermore, Gupta teaches that the price also depends on popularity of said web site (the number of times the web site is accessed by the audience), thereby obviously indicating monitoring effectiveness of said television or on-line program.

However, Gupta does not specifically teach that said monitoring effectiveness of said television or on-line program includes monitoring effectiveness of an *advertising campaign*. Also, Gupta does not specifically teach that said television or on-line program include a *contest*.

Benson teaches a method and system for real-time reporting of advertising effectiveness, said system including a server and a subscriber's terminal interconnected with the server via a network, wherein the effectiveness of the advertising campaign is monitored and results are reported to the subscriber over the network (C. 2, L. 46-48). The results indicate achievements of the campaign in terms of realized or lost sales (C. 10, L. 19-28).

Namanny teaches a method and system for conducting a televised competition, wherein said competition is a motorized racing, and wherein contestants wear clothing with a sponsor's name, trademark or logo (C. 5, L. 59-60).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Gupta to include monitoring effectiveness of an advertising campaign, as disclosed in Benson, because it would advantageously allow to discontinue ineffective advertising campaign, thereby save funds (Benson, C. 1, L. 41-44). And it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Gupta in view of Benson to include that said television or on-line program include a contest, as disclosed in Namanny, because the popularity of sport events would advantageously increase the audience, thereby potentially increase revenue.

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Claims 2. Gupta teaches negotiating the price for the advertisement slot over the client's computer (C. 16, L. 12-17).

Claim 6. Gupta teaches negotiating the price for the advertisement slot, said negotiation is conducted over the network between web server and the client's computer (C. 16, L. 12-20), thereby obviously indicating displaying selling price on a home page.

Claim 8. Gupta teaches presenting advertisement to audiences during television or on-line program, wherein the clients/advertisers negotiate the price for the advertisement slot over the network, said price depends on advertisement size and slot location on a web page (site) (C. 4, L. 5-18; C. 12, L. 42-47). Enabling said function obviously indicates providing necessary graphical user interface (GUI). Choosing the contestant is shown in Namanny (C. 7, L. 35-38). The motivation to combine Gupta in view of Benson and Namanny would be use of the popularity of sport events to increase the audience, thereby potentially increase revenue.

Claim 10. Gupta teaches structuring payment schemes for the advertisement slot based on the popularity of the web site (C. 4, L. 26-29), thereby obviously indicating increasing of the price with increasing audience rating.

Claim 11. Gupta teaches broadcasting a program over the Internet; and the audience rating is obviously indicated by the number of times the web site is accessed by the audience) (C. 4, L. 26-29).

Claim 12. See reasoning applied to claim 1. Information as to: holding the contest *in the theme park* is non-functional language and given no patentable weight. Non-functional descriptive material cannot render non-obvious an

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invention that would otherwise have been obvious. *See: In re Gulack* 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983) *In re Dembiczak* 175 F.3d 994, 1000, 50 USPQ2d 1614, 1618 (Fed. Cir. 1999). The specific example of non-functional descriptive material is provided in MPEP 2106, Section VI: (example 3) a process that differs from the prior art only with respect to non-functional descriptive material that cannot alter how the process steps are to be performed. The method steps, disclosed in Gupta in view of Benson and further in view of Namanny would be performed the same regardless where the contest is taking place.

Claim 16. Namanny teaches clothing (article) with a sponsor's name, trademark or logo; said clothing is worn by the contestants during a sport contest (C. 5, L. 59-60), thereby obviously indicating a plurality of areas for displaying advertisements. The motivation to combine Gupta in view of Benson and Namanny would be to attract big audience to watch a sport contest, thereby potentially increase revenue.

Claim 17. Namanny teaches the contestants wearing clothing with a sponsor's name, trademark or logo during the sport contest (C. 5, L. 59-60). The motivation to combine Gupta in view of Benson and Namanny would be to attract big audience to watch a sport contest, thereby potentially increase revenue.

Claim 24. See reasoning applied to claim 1. Information as to: *the contest is a contest of sumo, kenjutsu, igo, shogi, chess, science, culture or intellect* is non-functional language and given no patentable weight. Non-functional descriptive material cannot render non-obvious an invention that would otherwise have been obvious. *See: In re Gulack* 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983) *In re Dembiczak* 175 F.3d 994, 1000, 50 USPQ2d 1614, 1618 (Fed. Cir. 1999). The method steps, disclosed in Gupta in view of Benson and

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further in view of Namanny would be performed the same regardless of the type of the contest.

Claim 25. See reasoning applied to claim 1. Information as to: *wherein the contestant includes an individual, a team, and a work object* is non-functional language and given no patentable weight. Non-functional descriptive material cannot render non-obvious an invention that would otherwise have been obvious. See: *In re Gulack* 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983) *In re Dembiczak* 175 F.3d 994, 1000, 50 USPQ2d 1614, 1618 (Fed. Cir. 1999). The method steps, disclosed in Gupta in view of Benson and further in view of Namanny would be performed the same regardless who is the contestant.

Claims 3, 7 and 30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gupta in view of Benson, further in view of Namanny and further in view of Eldering (US 6,324,519 B1).

Claims 3, 7 and 30. Gupta in view of Benson and further in view of Namanny teaches all the limitations of claim 3, except specifically teaching: evaluating amounts proposed by buyers; and determining a successful buyer based on the highest proposed amount proposed by buyers.

Eldering teaches advertisement auction system and method, wherein buyers transmit desired bids from buyers terminals to a server; wherein buyers bid for the advertisement opportunity; the submitted bids are evaluated and the maximum bid is accepted (C. 1, L. 53-55; C. 2, L. 1-21).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Gupta in view of Benson and further in view of Namanny to include: evaluating amounts proposed by buyers; and determining a successful buyer based on the highest proposed amount proposed by buyers, as disclosed in Eldering, because it would advantageously allow to maximize revenue for providing advertisement opportunity (Eldering, c. 2, L. 20).

Claims 13, 22, 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gupta in view of Benson and further in view of Namanny.

Claims 13 and 22. Gupta in view of Benson and further in view of Namanny teaches all the limitations of claim 13, including providing a number (parameter) of total calls (sales) during a campaign (Benson, C. 10, L. 25-28), except specifically teaching that the selling price increases as the sales amount (achievements) increases.

However, it is old and well known that increase in popularity (sales) of a product leads to increase in product price. For example, good news about a company usually leads to increasing of company stock value.

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Gupta in view of Benson and further in view of Namanny to include that the selling price increases as the sales amount increases, because it would advantageously maximize revenue for the business.

Claim 23. Same reasoning as applied to claims 13 and 22.

Claim 18 is rejected under 35 U.S.C. 103(a) as being unpatentable over Gupta in view of Benson, further in view of Namanny and further in view of Hill (US 5,970,471).

Claim 18. Gupta in view of Benson and further in view of Namanny teach all the limitations of claim 18, except specifically teaching: receiving a selection from the potential buyer of the article; displaying an image of the selected article.

Hill teaches a virtual catalog and product presentation method and apparatus, comprising: displaying a plurality of product images on a display for

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review by a user; receiving a user input selecting a product image; and displaying the selected product image (C. 3, L. 13-21).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Gupta in view of Benson and further in view of Namanny to include: receiving a selection from the potential buyer of the article; displaying an image of the selected article, as disclosed in Hill, because it would advantageously allow the user to review/examine the article on the display before he/she make a payment, thereby minimizing return of purchased goods.

Claim 21 is rejected under 35 U.S.C. 103(a) as being unpatentable over Gupta in view of Benson, further in view of Namanny and further in view of Feezell et al. (US 6,253,189) (hereinafter Feezell).

Claim 21. Gupta in view of Benson and further in view of Namanny teach all the limitations of claim 21, except specifically teaching: a ranking coefficient for the contestant, wherein the selling price increases as the ranking coefficient increases.

Feezell teaches a method and system for completing advertising time slot transactions, wherein when a time slot for advertisement is offered; a time slot (and program in which the time slot occurs) marketing valuation/rating is conducted and provided to the buyers so that the buyers could accurately value the time slot (C. 3, L. 1-11; C, 7, L 51-52). Rating of the time slot (and program in which the time slot occurs) obviously indicate increase in value of the time slot as the ranking of the time slot increases.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Gupta in view of Benson and further in view of Namanny to include: ranking coefficient for the contestant, wherein the selling price of the time slot increases as the ranking increases, as indicated in Feezell, because it would advantageously allow buyers to evaluate offered time

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slots and identify those time slots which meet the buyer's requirements, and accurately value the time slots (Feezell; C. 3, L. 10).

Claims 26 and 32-33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gupta in view of Benson, further in view of Namanny, further in view of Feezell and further in view of DiCicco et al. (US 5,892,554) (hereinafter DiCicco).

Claim 26. Gupta in view of Benson, further in view of Namanny and further in view of Feezell teach all the limitations of claim 26, including a broadcasting frequency and broadcasting time (Feezell; C. 8, L. 58-65), except specifically teaching: a zoom ratio of the advertisement.

DiCicco teaches a method and system for inserting static and dynamic images into a live broadcast, wherein zoom ratio of the advertisement can be changed (C. 5, L. 59 – C. 6, L. 6; C. 12, L. 33-48).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Gupta in view of Benson, further in view of Namanny and further in view of Feezell to include: providing a zoom ratio, as disclosed in DiCicco, because it would advantageously allow buyers to evaluate offered time slots and identify those time slots which meet the buyer's requirements, and accurately value the time slots.

Claim 32. DiCicco teaches said method and system for inserting static and dynamic images into a live broadcast, wherein the display position and the display size of the advertisement can be changed (C. 5, L. 59 – C. 6, L. 6; C. 12, L. 33-48).

The motivation to combine Gupta in view of Benson, further in view of Namanny and further in view of Feezell and DiCicco would be to allow buyers to evaluate offered time slots and identify those time slots which meet the buyer's requirements, and accurately value the time slots.

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Claim 33. Gupta in view of Benson, further in view of Namanny, further in view of Feezell and further in view of DiCicco teach all the limitations of claim 33, except specifically teaching: using a mouse device for interaction with the buyer's terminal.

However, it is old and well known to use the mouse device for interaction with a computer.

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Gupta in view of Benson, further in view of Namanny, further in view of Feezell and further in view of DiCicco to include using of a mouse device for interaction with the buyer's terminal, because use of well know interface would advantageously simplify interaction with a computer.

Claim 27 is rejected under 35 U.S.C. 103(a) as being unpatentable over Gupta in view of Benson and further in view of Namanny.

Claim 27. Gupta in view of Benson and further in view of Namanny teach all the limitations of claim 27, except specifically teaching distributing profits from advertising between a contest management company and the player.

However, it is old and well known to pay players of sportsman for wearing a uniform with advertisement thereon.

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Gupta in view of Benson and further in view of Namanny to include distributing profits from advertising between a contest management company and the player, because it would advantageously stimulate famous players to participate in the contest, thereby increase audience.

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Examiner's Note

Examiner has cited particular columns and line numbers or figures in the references as applied to the claims for the convenience of the applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested from the applicant, in preparing the responses, to fully consider the references in entirety as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the examiner.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure (see form PTO-892).

The following foreign patent is cited to show the best foreign art found by the examiner: Strachan (GB 2258065 A) discloses television program and advertising data analysis wherein advertisement rating of the current show is continuously monitored and provided to a user to facilitate input of bookings data.

The best NPL prior art, Pfalzgraf, discloses buying by a company time spots during live sports broadcasts for advertising company' products.

Examiner suggests the Applicant review these documents before submitting any amendment.

Any inquiry concerning this communication should be directed to Igor Borissov at telephone number (703) 305-4649.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Receptionist whose telephone number is (703) 308-1113.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's Supervisor, John Weiss, can be reached at (703) 308- 2702.

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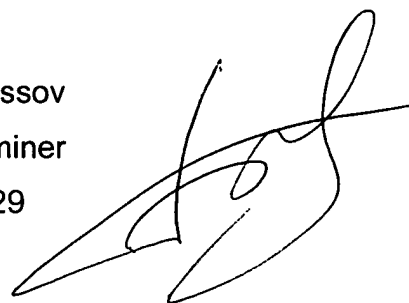
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Igor N. Borissov
Patent Examiner
Art Unit 3629

A handwritten signature in black ink, appearing to be 'Igor N. Borissov', written over a faint, stylized outline of a signature.

IB

10/04/2004